

## REMARKS/ARGUMENTS

This amendment is submitted in response to the final Office Action of April 28, 2003, identified as Paper No. 8. Claims 39-55 remain pending in the application.

In the Action, the Examiner rejected claims 52, 54, and 55 under 35 U.S.C. § 112, second paragraph as indefinite. Claims 1-43 were rejected under 35 U.S.C. § 112, ¶ 1 as containing subject matter not adequately described in the specification. Claims 1-3, 8, 10-14, 21-22, 25-27, 32, 34-36, and 39-41 stand rejected under 35 U.S.C. § 103(a) as obvious in light of U.S. Patent No. 6,127,094 to Victor et al. ("Victor"). Claims 4-5 and 28-29 were rejected under 35 U.S.C. § 103(a) as obvious in light of Victor in view of Marks.

With regard to the rejection of claims 52, 54, and 55, Applicant has amended claims 52 and 54 to depend from claims 51 and 53, respectively, thereby alleviating the antecedent basis problem. Applicant has also rewritten claim 55 in independent form. As indicated in Applicant's previous Amendment, claim 55 was rewritten to overcome the objection to original claim 33, which was held allowable but presented in dependent form.

With regard to the written description rejection, Applicant respectfully submits that the limitation to "at least 25 percent by weight" of the claimed bisphenol-A derivative is sufficiently supported by the specification within the meaning of 35 U.S.C. § 112, ¶ 1. The Examiner's requirement that the specification demonstrate that the claimed range is critical is improper. Criticality is instead only relevant if the claimed range is obvious in light of the prior art, *i.e.*, it overlaps or abuts the prior art. *See In re Geisler*, 43 U.S.P.Q.2d 1362 (Fed. Cir. 1997). That is not the issue here. As indicated by the Examiner, the added limitation of "at least 25 percent by weight" would otherwise overcome the various rejections in view of *Marks*. Indeed, Applicant pointed out in the previous Amendment how the prior art specifically teaches away from the

claimed range. Thus, there is no need for Applicant to demonstrate criticality or “unexpected results” for the claimed range because the claimed range is not obvious in light of the prior art. *Geisler*, 43 U.S.P.Q. at 1364 (holding that obviousness can be rebutted by showing unexpected results *or* teaching away). Accordingly, there is no requirement that the specification teach criticality or unexpected results in order to adequately support a claimed range.

Whether there is a sufficient description of criticality is a question that only arises should an applicant rely on unexpected results as a basis for overcoming an obviousness rejection.

In order to fulfill the written description requirement, the specification need only demonstrate that the inventor was in possession of the claimed invention at the time of filing the application. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 U.S.A.P.Q.2d 1111, 1117 (Fed. Cir. 1991). Without question, the specification discloses that the inventor possessed formulations falling within the claimed range. In fact, most of the Examples in the specification involve levels of bisphenol-A derivative that fall within the claimed range. Thus, the specification clearly evidences that formulations including at least 25 percent by weight of a bisphenol-A derivative were well within the contemplation of the Applicant.

The specification does not fail to give adequate support for this limitation merely because some embodiments in the specification fall outside the claimed range. As the Federal Circuit held in *Union Oil Co of California v. Atlantic Richfield Co.*, 54 U.S.P.Q.2d 1227, 1235 (Fed. Cir. 2000), the written description requirement should not “eviscerate claims that are narrowed during prosecution, simply because the patent applicant broadly disclosed in the original patent application.” Along these lines, the Court of Customs and Patent Appeals has held that a disclosure of 25 to 60 percent in the specification adequately supported a claimed range of “at least 35%.” *In re Wertheim*, 541 F.2d 257, 265, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976). A similar

result should follow here. Applicant adequately disclosed a range of formulations that overlap the claimed range, thereby establishing that the claimed invention was within the possession of the Applicant and fulfilling the written description requirement under 35 U.S.C. § 112, ¶ 1.

Despite Applicant's traversal of the 35 U.S.C. § 112, ¶ 1 rejection, claims 1-38 have been withdrawn without prejudice to Applicant's right to present these claims in a continuing application. Applicant has also removed the limitation forming the basis for the 35 U.S.C. § 112, ¶ 1 rejection in accordance with the Examiner's suggestion for placing claims 39-43 claims into condition for allowance. Applicant notes, however, that despite the Examiner's indication that these claims would be allowable if the purported "new matter" was removed, claims 39-41 were listed among those rejected under 35 U.S.C. § 103(a) in view of *Victor*. Applicant respectfully requests clarification of whether the claims 39-41 have been placed into condition for allowance.

Enclosed is a change of correspondence address.

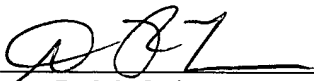
A check in the amount of \$55 and Petition for One Month Extension of Time are enclosed.

The Commissioner is authorized to charge any deficiencies or credit any over-payment to Deposit Account 50-1546.

In view of the foregoing amendments, the Examiner's reconsideration is requested and allowance of the present application is believed to be in order. If the Examiner believes a phone conference with Applicant's attorney would expedite prosecution of this application, he is respectfully requested to contact him at (315) 218-8515.

Respectfully submitted,

Dated: August 19, 2003

By:   
George R. McGuire  
Reg. No. 36,603

BOND, SCHOENECK & KING, PLLC  
One Lincoln Center  
Syracuse, New York 13202-8530  
315-218-8515